

Remarks

Applicants have amended claim 7 and cancelled claims 3, 6, 8-11 and 13-15 without prejudice or disclaimer in an effort to expedite prosecution. Following entry of the present amendment, claims 4, 5, 7 and 12 remain pending.

I. Information Disclosure Statement

Applicants wish to thank the Examiner for noting the absence of the following reference from the IDS filed on 1/20/2006. Applicants will submit a supplemental information disclosure statement which contains the requested copy of the reference within the next three business days.

Augustyns, K. et al., "The Unique Properties of Dipeptidyl-Peptidase IV (DPP IV/CD26) and the Therapeutic Potential of DPP IV Inhibitors", Current Medicinal Chemistry, V6, N4, 1999, pp. 311-327.

II. Claim rejections under 35 U.S.C § 102(b)

The Office Action states claims 1 and 3-14 are rejected under §102(a) as being anticipated by the PCT Publication WO 03/002531 to Haffner *et al.* (Haffner). The Office Action states that Haffner teaches "(2S,4S)-4-fluoro-1-[4-fluoro-β-(4-fluorophenyl)-L-phenylalanyl]-2-pyrrolidinecarbonitrile or a salt, solvate, or pharmaceutically functional derivative thereof."

Applicants submit, as set forth in the application as filed and as indicated by the reference, that the present anhydrous form 1 of (2S,4S)-4-fluoro-1-[4-fluoro-β-(4-fluorophenyl)-L-phenylalanyl]-2-pyrrolidinecarbonitrile *p*-toluenesulfonic acid salt was not known prior to the present invention. Anhydrous form 1 has novel and nonobvious crystalline structures and physical properties as indicated by its x-ray diffractometry, Raman spectrum, and decomposition temperature as recited in the present application. Applicants respectfully submit that differences among various solid-state forms of a compound, can translate into patentable differences in biological activity and efficacy and stability of the final pharmaceutical product.

Applicants believe it is well established that "[a]nticipation requires the presence in a single prior art reference disclosure of every element of the claimed invention."

Great Northern Corp. v. Davis Core & Pad. Co., Inc., 228 U.S.P.Q. 356, 358 (Fed. Cir. 1986).

Among those features that are absent from the Haffner reference, yet claimed in applicants' pending independent claim 4, include the following:

1. the *p*-toluenesulfonic acid salt limitation is not taught by Haffner.
2. the anhydrous form limitation is not taught by Haffner.
3. the crystalline form having the particular claimed XRPD pattern limitation is not taught by Haffner.

Furthermore, Example 2 of the Haffner reference describes the synthesis of (2*S*,4*S*)-4-fluoro-1-[4-fluoro- β -(4-fluorophenyl)-L-phenylalanyl]-2-pyrrolidinecarbonitrile, yet makes no mention of producing the now claimed crystalline form. See page 49 of the PCT published application WO 03/002531 to Haffner. Instead, Example 2 describes precipitating the present compound by adding HCl followed by addition of diethyl ether. There is no teaching in this Example as to whether the resulting precipitate is an amorphous form or any particular crystalline form, let alone applicants presently claimed crystalline "form 1".

Applicants respectfully submit that claims 4, 5, 7 and 12 are patentably distinct from Haffner; and therefore, request favorable reconsideration of this rejection under 35 U.S.C. §102(a).

III. Claim rejections under 35 U.S.C § 112

The Office Action states claims 13 and 14 are rejected under 35 USC §112, first paragraph, as failing to comply with the enablement requirement. In particular, the Office Action stated that while enabling for the treatment of diabetes, the specification was not enabled for "prophylaxis" of diabetes.

Applicants believe the present rejection under section 112 is mooted by the cancellation of claims 13 and 14 in an effort to expedite prosecution.

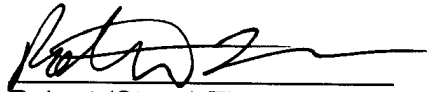
IV. Obviousness-type double patenting rejections

Claims 1 & 3-14 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 7,132,443 ('443). The Office Action stated that "although the conflicting claims are not identical,

they are not patentably distinct from each other because they are drawn to overlapping subject matter." Applicants submit that for the same reasons set forth in discussing the section 102(a) rejection above, the pending claims are neither taught nor suggested by the '443 patent.

Applicants believe the present claims are in condition for allowance and such action is respectfully requested. If the Examiner has any outstanding issues with the pending claims, he is encouraged to telephone the undersigned at (919) 483-8406 for expeditious handling.

Respectfully submitted,



Robert (Steve) Thomas
Attorney for Applicants
REGISTRATION NO. 52,284

Date: 4/28/2009
Customer No. 23347
GlaxoSmithKline
Corporate Intellectual Property
Five Moore Drive, P.O. Box 13398
Research Triangle Park, NC 27709-3398
Telephone: (919) 483-8406
Facsimile: (919) 483-7988